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OFFICE OF PETITIONS

In re Application of
Stephen L. Crooks, et al
Application No. 10/027,272
Filed: December 21, 2001
Attorney Docket No. 54913US108

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:DECISION DISMISSING
:PETITION UNDER 37 CFR
:1.78(a)(3) AND 37 CFR
:1.78(a)(6)

This is a decision on the petition, filed November 25, 2002, which is being treated both as a petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 119(e) and 120 for the benefit of priority to nonprovisional Application Nos. 10/166,321, filed June 15, 2001 (converted from provisional Application No. 60/298,768) and 09/589,216, filed June 7, 2000, and provisional Application No. 60/138,365, filed June 10, 1999.

The petition is DISMISSED.

A petition for acceptance of a claim for late priority is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 119(e) and 120 and 37 CFR 1.78(a)(2)(i) and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;¹

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international

- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition lacks item (1) above.

The "Preliminary Amendment," filed concurrently with the instant petition, contains the following language:

Cross Reference to Related Applications

This application is a continuation of U.S. Application No. 10/166,321, filed June 15, 2001, now pending, **which claims the benefit** of U.S. Application No. 09/589,216, filed June 7, 2000, issued as U.S. Patent No. 6,331,539 B1, which claims the benefit of Provisional Application No. 60/138,365, filed on June 10, 1999 [emphasis supplied].

The claim for benefit of the above-noted prior-filed applications cannot be entered at this time. In this regard, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) **and indicating the relationship of the applications**. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of

applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

states: "This application claims the benefit of Application No. 10/---, filed ---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure (8th ed., August 2001), Section 201.11, Reference to First Application.

If nonprovisional Application No. 09/589,216, filed June 7, 2000, and provisional Application No. 60/138,365, filed June 10, 1999, which are the subject of the instant petition, are merely related applications, a mere cross reference to these related applications should be included in the specification following the title of the invention.

A further review of Office computer database records indicates that nonprovisional Application No. 10/166,321 lacks a common inventorship with the instant application and the other applications to which petitioner herein seeks priority. The statute requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. § 119(e) or 120 be filed by an inventor or inventors named in the prior-filed nonprovisional or provisional application.

For the above-noted reasons, the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) cannot be granted at this time.

If reconsideration of this decision is desired, and in order to expedite consideration thereof, petitioner may wish to submit the renewed petition by facsimile transmission to the number indicated below and to the attention of the undersigned.

The "Associate Power of Attorney" accompanying the instant petition has been made of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
 P.O. Box 2327
 Mail Stop DAC
 Arlington, VA 22202

OR

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center AU 1625 for appropriate action on the reply received November 25, 2002 to the nonfinal Office action of July 29, 2002.



Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy